UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/645,660	08/24/2000	Jesus Mena	L9406-002	3538

7590 04/20/2005

Patterson Belknap Webb & Tyler L L P
Attn IP Department
1133 Avenue of the Americas
New York, NY 10036

EXAMINER	
LEE, PHILIP C	
ART UNIT	**PAPER NUMBER**
2154	

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/645,660	MENA, JESUS	
	Examiner	Art Unit	
	Philip C Lee	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 February 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3 and 5-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3 and 5-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. This action is responsive to the amendment and remarks filed on February 28, 2005.

2. Claims 1-3 and 5-22 are presented for examination.

3. The text of those sections of Title 35, U.S. code not included in this office action can be found in a prior office action.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-3, 5, 8 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaminsky et al, U.S. Patent Application Publication 2002/0112096 (hereinafter Kaminsky) in view of Katz et al, U.S. Patent 6,055,513 (hereinafter Katz).

6. As per claim 1, Kaminsky taught the invention substantially as claimed comprising:

one or more subscriber servers for collecting information identifying a user and providing a first data set of user information (e.g. differentiating indicator incorporating end user identifier) (page 1, paragraph 15-page 2, paragraph 16); and

a processor (e.g. CPU) in operative communication with the one or more subscriber servers and receiving said first data set from the one or more subscriber servers and a second data set with demographic data (page 1, paragraph 15-page 2, paragraph 16; page 5, paragraph 59; page 7, paragraphs 86-87),

said processor (e.g. CPU with server scoring engine) including a rule processor receiving said first data set (e.g. differentiating indicator with end user identifier) and said second data set (e.g. demographic data) and applying said first and second data sets to one or more rules (e.g. predefined algorithm) to determine a score predicting behavior relating to said collected information identifying said user (page 2, paragraph 16; page 5, paragraph 59; page 7, paragraphs 86-87; page 6, paragraph 69).

7. Kaminsky did not teach said second data set is provided by one or more demographic database. Katz taught a similar system comprising:

a processor in operative communication with one or more demographic databases and receiving a second data set from the one or more demographic databases (fig. 2; col. 18, line 40-col. 19, line 15; col. 23, line 6-19); and

one or more demographic databases having third party information relating to targeted market segments and providing a second data set of said third party information relating to targeted market segments (col. 8, lines 63-col. 9, lines 2; col. 9, line 65-col. 10, line 19; col. 18, line 40-col. 19, line 15; col. 23, lines 6-19).

8. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Kaminsky and Katz because Katz's system of receiving a second data set from one of more demographic databases would increase the efficiency of Kaminsky's system by allowing third party database (e.g. demographic database) to provide responsive, effective information to system for marketing determination (col. 10, lines 15-19).

9. As per claim 14, Kaminsky taught the invention substantially as claimed comprising the steps of:

> receiving from one or more subscriber servers user-identifying indicia and providing a first data set of user information (e.g. differentiating indicator incorporating end user identifier) (page 1, paragraph 15-page 2, paragraph 16);
>
> applying said first data sets (e.g. differentiating indicator with end user identifier) and a second data set with demographic data to one or more rules (e.g. predefined algorithm) to determine a score predicting behavior relating to the user-identifying indicia (page 2, paragraph 16; page 5, paragraph 59; page 7, paragraphs 86-87; page 6, paragraph 69); and
>
> communicating the predictive score to the one or more subscriber servers (page 5, paragraph 59; page 7, paragraph 87).

10. Kaminsky did not teach said second data set is provided by one or more demographic database. Katz taught a similar system comprising:

generating from the user-identifying indicia a key which corresponds to values indexed by one or more demographic databases having third party information (col. 9, lines 47-57; col. 22, lines 51-67);

communicating the key to the one or more demographic databases (col. 9, lines 47-57; col. 22, lines 51-67); and

receiving from the one or more demographic databases demographic information relating to the user-identifying indicia and providing a second data set (col. 8, lines 63-col. 9, lines 2; col. 9, line 65-col. 10, line 19; col. 18, line 40-col. 19, line 15; col. 23, lines 6-19).

11. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Kaminsky and Katz because Katz's system of receiving a second data set from one of more demographic databases would increase the efficiency of Kaminsky's system by allowing third party database (e.g. demographic database) to provide responsive, effective information to system for marketing determination (col. 10, lines 15-19).

12. As per claim 2, Kaminsky and Katz taught the invention substantially as claimed in claim 1 above. Katz further taught wherein the processor receives the first data set of user information from one of the subscriber servers and generates a unique key corresponding to the collected information identifying a user (col. 9, lines 47-57; col. 22, lines 51-67).

13. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Kaminsky and Katz because Katz's system of generates a unique key corresponding to the collected information identifying a user would increase the security of Kaminsky's system by preventing confidential information identifying a user to be easily accessed by identity thief.

14. As per claim 3, Kaminsky and Katz taught the invention substantially as claimed in claim 2 above. Kaminsky further taught wherein the one or more subscriber servers communicate to the processor said first data set of user information about the user based on information identifying the user (page 5, paragraph 59).

15. As per claim 5, Kaminsky and Katz taught the invention substantially as claimed in claim 1 above. Kaminsky further taught wherein the processor communicates the score to the one or more subscriber servers (page 5, paragraph 59; page 7, paragraph 87).

16. As per claim 8, Kaminsky and Katz taught the invention substantially as claimed in claim 2 above. Katz further taught wherein the unique key corresponds to values indexed by the one or more demographic databases (col. 9, line 47-col. 10, line 7).

17. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Kaminsky and Katz because Katz's system of the unique key corresponding to values indexed by the one or more demographic databases would increase

the security of Kaminsky's system by preventing confidential information identifying a user to be easily accessed by identity thief.

18. As per claim 13, Kaminsky and Katz taught the invention substantially as claimed in claim 1 above. Kaminsky and Katz further taught wherein

the one or more subscriber servers are coupled to an Internet (see Kaminsky, 102, fig. 1);

the one or more demographic databases are coupled to the Internet (see Katz, col. 19, lines 41-49; col. 17, liens 4-7); and

the processor is coupled to the Internet (see Kaminsky, 110 and 114, fig. 2).

19. Claims 6-7 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaminsky and Katz in view of Lazarus et al, U.S. Patent 6,134,532 (hereinafter Lazarus).

20. Lazarus was cited in the last office action.

21. As per claims 6 and 7, Kaminsky and Katz taught the invention substantially as claimed in claim 5 above. Kaminsky and Katz did not specifically teach using the score for selectively marketing products and service. Lazarus taught wherein the one or more subscriber servers use the score communicated by the processor to selectively market products and services to the user (col. 22, lines 45-64).

22. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Kaminsky, Katz and Lazarus because Lazarus's method of using the score for selectively marketing products and service would increase the effectiveness of Kaminsky's and Katz's system by allowing targeted information such as advertisement to presented based on a behavior basis to increase the customer response (col. 1, lines 11-13; col. 7, lines 22-27).

23. As per claims 17 and 19, Kaminsky and Katz taught the invention substantially as claimed in claims 1 and 14 above. Kaminsky and Katz did not specifically the score indicating a likelihood that the user will make a purchase. Lazarus taught determining a score to select an advertisement based on the user's propensity to make a purchase (col. 19, lines 9-15; col. 22, lines 52-57; col. 25, lines 8-15).

24. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Kaminsky, Katz and Lazarus because Lazarus's method of using the score for indicating a likelihood that the user will make a purchase would increase the alertness of the seller by allowing product and service to be targeted to potential user based on the score.

25. As per claim 18 and 20, Kaminsky and Katz taught the invention substantially as claimed in claims 1 and 14 above. Kaminsky and Katz did not teach using a neural network. Lazarus taught wherein the score is determined using a neural network (col. 20, lines 43-45).

26. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Kaminsky, Katz and Lazarus because Lazarus's method of determining a score using a neural network would increase the flexibility of Kaminsky's and Katz's systems by allowing score to be determined using other types of method as a design choice of the user.

27. Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaminsky and Katz in view of Gerace, U.S. Patent 5,848,396 (hereinafter Gerace).

28. Gerace was cited in the last office action.

29. As per claims 15 and 16, Kaminsky and Katz taught the invention substantially as claimed in claim 14 above. Kaminsky and Katz did not specifically detail type of applications based on the score. Gerace taught the step of the subscriber server determining whether or not to offer a user a product based on the score (abstract; col. 2, lines 46-53).

30. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Kaminsky, Katz and Gerace because Gerace's system of determining whether or not to offer a user a product based on the score would increase the likelihood of selling a product in Kaminsky's and Katz's systems by targeting users with score indicating a tendency to purchase similar product.

31. Claims 9-12 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaminsky and Katz in view of "Official Notice".

32. As per claims 9-12, Kaminsky and Katz taught the invention substantially as claimed in claims 2 and 8 above. Although, Katz taught wherein the unique key comprises Social Security Number (col. 9, lines 22-57; col. 22, lines 57-67), however, Kaminsky and Katz did not specifically detailing other type of unique keys. "Official Notice" is taken for the concept of other type of unique keys is known and accepted in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include other type of unique keys because by doing so it would increase the flexibility of the user by using different type of keys as a design choice.

33. As per claims 21 and 22, Kaminsky and Katz taught the invention substantially as claim in claims 1 and 14 above. Although, Kaminsky taught wherein the third party information relating to targeted market segments includes income and age, however, Kaminsky and Katz did not specifically detailing other type of third party information. "Official Notice" is taken for the concept of including other type of third party information such as gender and occupation of the user is known and accepted in the art. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to include the other type of third party information to increase the field of use.

34. Applicant's arguments with respect to claims 1-3 and 5-22, filed 2/28/05, have been fully considered but are not deemed to be persuasive and are moot in view of new ground of rejection.

CONCLUSION

35. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Java, U.S. Patent Application Publication 2005/0021747, disclosed a method of establishing a global interest profile of a user.

Anderson et al, U.S. Patent 6,078,892, disclosed a method of determining a score for the relevancy of an item to a user.

Lazarus et al, U.S. Patent 6,134,532, disclosed a system of matching user with relevant entity.

36. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Lee whose telephone number is (571)272-3967. The examiner can normally be reached on M-F 8-5. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571)272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an

application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

P.L.